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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,584	09/25/2003	Patrick Vanmechelen	1316N-001671	7456

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HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER

KRAMER, DEVON C

ART UNIT PAPER NUMBER

3683

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/670,584

Applicant(s)

VANMECHELEN ET AL.

Examiner

Devon C Kramer

Art Unit

3683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-9, 14 and 15 is/are rejected.
- 7) ☒ Claim(s) 3-4 12-13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/25/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

- 1) Applicant's election without traverse of species 3 in Paper No. 5/11/04 is acknowledged.
- 2) Claims 10-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5/11/04.

Drawings

- 3) The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the second biasing member (circlip, claim 15) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Please note that applicant claims a first circlip in claim 13.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

- 4) The disclosure is objected to because of the following informalities:
Page 10 paragraph 22 line 10, "clip" should be -lip--.
Appropriate correction is required.

Claim Rejections - 35 USC § 112

- 5) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 6) Claims 6-7 and 14-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6-7 and 14 cite "said biasing member". Since there are two biasing members cited in the application it is unclear to which biasing member applicant is referring.

Claim Rejections - 35 USC § 102

- 7) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 8) Claims 1-2 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Driessen et al (5107970).

In re claim 1, Driessen et al provides a shock absorber comprising: a pressure tube (14) defining a working chamber (figure 1); a piston (18) disposed within said working chamber, said piston dividing chamber into an upper working chamber and a lower working chamber, a piston rod (22) attached to said piston, said piston rod extending from said piston through one end of said pressure tube; a rod guide (80, 24) disposed between said one end of said pressure tube and said piston rod; and a sealing

system (Figure 3) disposed between said rod guide and said piston rod, said sealing system comprising a slip ring (94) disposed between said piston rod and the rod guide, said slip ring slidably engaging said piston rod; and a first biasing member (96) urging said slip ring into engagement with the piston rod and the rod guide.

In re claim 2, see figure 1, please note that a portion of the slip ring is pushed against a portion of the rod guide.

In re claim 8, see figure 3.

9) Claims 1, 5 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamaguchi et al (2001/0023638)

In re claim 1, Yamaguchi et al provides a shock absorber comprising: a pressure tube (2) defining a working chamber (A); a piston (figure 1) disposed within said working chamber, said piston dividing chamber into an upper working chamber and a lower working chamber, a piston rod (5) attached to said piston, said piston rod extending from said piston through one end of said pressure tube; a rod guide (15, 16) disposed between said one end of said pressure tube and said piston rod; and a sealing system (Figure 18) disposed between said rod guide and said piston rod, said sealing system comprising a slip ring (26) disposed between said piston rod and the rod guide, said slip ring slidably engaging said piston rod; and a first biasing member (30, 33) urging said slip ring into engagement with the piston rod and the rod guide.

In re claim 5, Yamaguchi et al provides a bearing (19) disposed between the guide rod and the piston rod, the first biasing member being disposed between the

bearing and the slip ring. Please note that a portion of the biasing member in Figure 18 is positioned between the bearing and the slip ring.

In re claim 8, see figure 18.

Claim Rejections - 35 USC § 103

10) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11) Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al (2001/0023638).

In re claim 9, Yamaguchi et al lacks the teaching of a circlip to bias a slip ring.

Yamaguchi et al does depict the use of a circlip to bias a seal member (22).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the biasing member for the slip ring of Yamaguchi et al with a circlip like that used to bias the other seal member merely because they are alternate equivalents in the art and are a known durable efficient means to bias seals.

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12) Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al (2001/0023638) (claims 6 and 7) or Driessen et al (5107970) (Claim 7) in view of Lizell et al (5363945).

Both Yamaguchi et al and Driessen et al lack the teaching of a spring washer.

Lizell et al teaches the use of a spring washer to bias parts in a seal assembly.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the biasing member of Yamaguchi or Driessen with a spring washer as taught by Lizell et al merely because they are alternate equivalents in the art and a spring washer is a known durable, strong means to bias parts.

Allowable Subject Matter

13) Claims 3-4 and 12-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14) Claims 14-15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

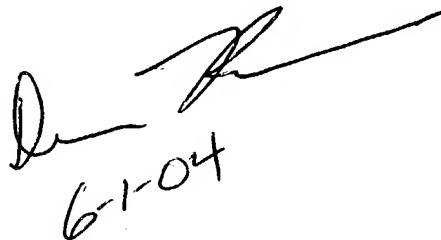
15) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Deppart et al, Umetsu, Muller et al, Machida et al and Yamaoka et al all provide seal assemblies with similar aspects to instant application.

16) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Devon C Kramer whose telephone number is 703-305-0839. The examiner can normally be reached on Mon-Fri 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on 703-308-3421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DK



Handwritten signature and date: 6-1-04